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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/750,918      | 12/31/2003  | John F. Mair         | MAIR-101            | 1895             |

7590

11/28/2005

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| EXAMINER |
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SELF, SHELLEY M

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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3725

DATE MAILED: 11/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |  |               |  |
|------------------------------|-----------------|--|---------------|--|
| <b>Office Action Summary</b> | Application No. |  | Applicant(s)  |  |
|                              | 10/750,918      |  | MAIR, JOHN F. |  |
|                              | Examiner        |  | Art Unit      |  |
|                              | Shelley Self    |  | 3725          |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 6,7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/1/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Drawings*

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “1” has been used to designate both motor housing (pg. 19, line 6; pg. 20, line 8) and router (pg. 19, line 8) and reference character “9” has been used to designate both lower surface (pg. 19, line 12) and base (pg. 20, line 1)

Additionally, reference character “13” has been used to designate both lower face (pg. 19, line 20) and lower surface (pg. 20, line 2), it is not clear if the terms *surface* and *face* are synonymous, or if they refer to different structure(s). Additionally the claims appear to use the terms, surface and face interchangeably (see clm. 1 reference to upper and lower faces...the lower surface). Examiner suggests use of one term for consistency or different reference characters if the two are separate elements of the invention.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

The disclosure is objected to because of the following informalities:

The page numbers listed at the top center of each page do not correlate to the page numbers listed in the bottom left corner. For the purposes of consistency any pages numbers referred to in this Office Action are those at the top center of each page in the disclosure.

Pg. 20, line 8, delete repeated words, --and set--

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 1, there is insufficient antecedent basis for "*the pad lower surface*" (lines 3-4), the claim positively recites a lower face, but it is unclear as to whether the face and the surface are the same. Clarification is required.

With regard to claims 8 and 10, there are no or insufficient antecedent bases within the claim(s) for the following:

"*the sub-base*" (clm. 8, line 2; clm. 10, line 3)

"*the present invention*" (clm. 8, line 2; clm. 10, line 3)

"*the collet*" (clm. 8, line 4; clm. 10, line 5)

"*the ends*" (clm. 8, line 5)

*“the distal end”* (clm. 10, lines 7-8)

*“the main part”* (clm. 9, line 2)

Further regarding claims 8-10, it is unclear what is meant by *“the present invention”*, since the claims appear to be drawn to a method of cutting a plug... (clm. 8) and method for creating custom wooden pieces... (clm. 10) as stated respectively by their preamble. What is “the present invention” is it separate from the method(s)? If Applicant is trying to incorporate the structure of the apparatus claims into the method claims, such should be clearly and positively recited. Merely reciting, *“the present invention”* renders the claim unclear and indefinite, as the apparatus of claim 1 is different from that of claim 6. Accordingly, it is unclear what the recitation of *“the present invention”* within the method refers to. Correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

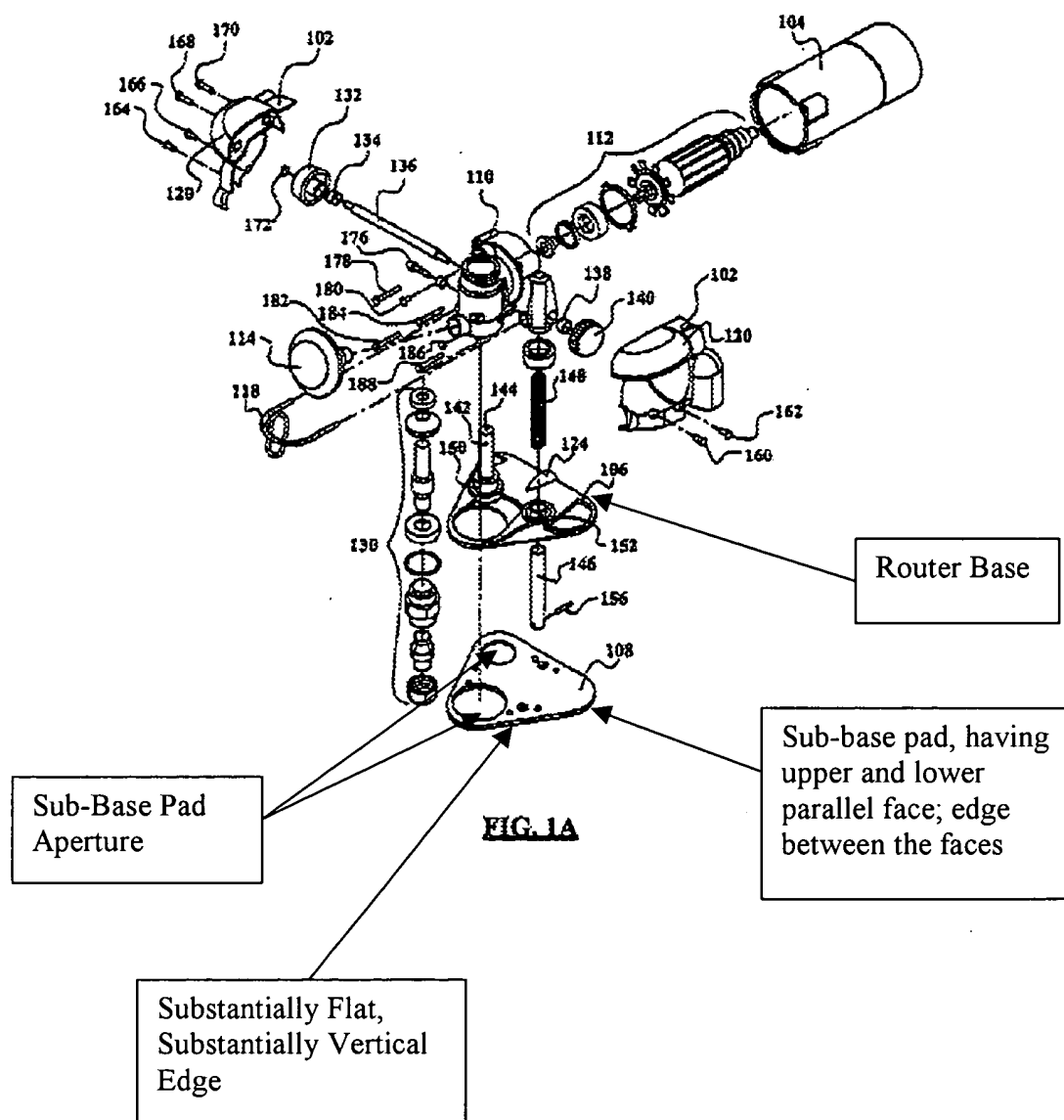
A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 as best as can be understood is rejected under 35 U.S.C. 102(e) as being anticipated by Phillips et al. (6,846,138). Phillips discloses a router sub-base comprising: a pad (108) of material having an upper face and a lower face (fig. 1A), and an edge (fig. 1A), the pad upper and lower faces are substantially flat and smooth the pad upper face is substantially parallel to the pad lower face, the pad edge is substantially perpendicular to the pad upper and

Art Unit: 3725

lower faces, the pad is of substantially uniform thickness and large enough to cover substantially the entire lower surface of a router base (106) to which the pad may be attached, and means for attaching (col. 6, lines 36-38) the pad (108) to the router base (106).



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5 and 8-10 as best as can be understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (6,846,138) in view of Judkins (4,461,330). With regard to claim 2, Phillips discloses the edge of the pad (108) presents a substantially flat, substantially vertical surface toward an arbor (130). Phillips does not disclose a collet. Judkins teaches in a similar art an offset router having a cutting tool (22) attached to a collet (col. 1, lines 61-64) wherein the cutting tool and collet are off center from the motor (12) center of gravity (fig. 2). Judkins teaches the use of a collet so as to hold or contain a cutting tool with respect to the motor. Phillips discloses the use of an arbor (130) assembly for holding a cutting tool (col. 3, lines 30-33). Because the references are from a similar art and deal with a similar problem (i.e., attaching/holding a cutting tool relative to a motor on a router/trimmer/shaper machine) it would have been obvious at the time of the invention to one having ordinary skill in the art to replace Phillips' arbor assembly (130) with a collet so as to efficiently hold contain the cutting tool relative to the motor as taught by Judkins.

With regard to claim 3 as best as can be understood, Phillips discloses a channel (fig. 1A). Examiner notes a channel to be a flow through passage, communication. Further the claim as written does not prohibit a thru-hole channel.

With regard to claim 4 as best as can be understood, Phillips discloses the channel to be deep enough and wide enough to allow projections cut by a cutting bit (130) engaged in the router to slide through the channel without restricting movement of the pad (col. 6, lines 15-26). Examiner notes Phillips' aperture in the sub-base pad (108) to act as channel facilitating movement of chippings cut from the workpiece to the cavity between the router base (106) and sub-base pad (108) to the portal for chip/dust removal.

With regard to claim 5, Phillips discloses the router as an offset router (fig. 1A)

With regard to claims 8-10, as best as can be understood Phillips discloses a method for cutting a projection/creating custom wooden pieces comprising attaching a sub-base (108) to an offset router (100), setting the router (100) on a flat surface (fig. 11), moving the router across a workpiece. Phillips does not explicitly disclose turning the router on. As noted above, Judkins teaches in a similar art the use of an offset router. Judkins teaches the construction of an offset router for improved functionality in routing a workpiece, i.e., provide benefits of both a convention (non-offset) router and a radial arm router (col. 2, lines 10-19) and controlling power of the router via a switch (46), i.e., turning the power on. Judkins further teaches the use of adjusting a cutting bit (col. 2, lines 13-15) so as to perform various router operations on a workpiece. Because the references are from a similar art as noted above, it would have been obvious to one having ordinary skill in the art to replace Phillips cutting tool with an adjustable tool so as to efficiently rout/trim/shape a workpiece as desired as taught by Judkins

As to moving a main part (clm. 9), as best as can be understood, Phillips discloses a main part of the router over a workpiece/plug/projection to be cut. Examiner notes in Phillips the majority and main part of the router extends over the workpiece (fig. 110).



***Allowable Subject Matter***

Claims 6 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not disclose or fairly suggest *the thickness of the pad is sufficient to position a distal end of the router bit ten one-thousandths of an inch from a flat surface* in combination with the rest of the claimed limitation as set forth in claim 6.

The prior art reference, Phillips discloses an offset router (100) having a router base (106) affixed to a sub-base pad (108) wherein the pad has an upper and lower face, the faces being parallel and an vertical edge connecting the upper and lower faces. Phillips does not disclose *the thickness of the pad is sufficient to position a distal end of the router bit ten one-thousandths of an inch from a flat surface*. Although Phillips cutting tool/bit (130) is positionable so as to rout/trim/shape a workpiece, Phillips is silent to positioning relative to the sub-base thickness. Further Applicant's disclosure states criticality of ten one-thousandths of an inch as it relates to the overall distance of the router bit/cutting tool relative to the sub-base thickness and flat surface upon which the router is placed for removing a plug/projection from a workpiece (Disclosure, pg. 9, lines 6-19). Therefore, Phillips fails to disclose or render obvious the claimed invention as set forth in claim 6.

Prior art reference, Judkins as noted above also discloses an offset router. Judkins further discloses the router to have a collet for holding the tool/bit and such to be adjustable vertically to

Art Unit: 3725


rout/trim/shape a workpiece (col. 2, lines 11-15). Judkins however fails to disclose a sub-base and does not disclose or fairly suggest any positioning of the cutting/tool relative to the sub-base (26) of the router or *the thickness of the pad is sufficient to position a distal end of the router bit ten one-thousandths of an inch from a flat surface*. Accordingly, Judkins fails to anticipate or render obvious the claimed invention as set forth in claim 6.

Neither the prior art of record nor any combination thereof discloses the claimed invention as set forth in claim 6. Accordingly, claim 6 and 7 (based on its dependency to claim 5) contain allowable subject matter over the prior art of record.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is (571) 272-4524. The examiner can normally be reached Mon-Fri from 8:30am to 5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, Derris Banks can be reached at (571) 272-4419. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular and After Final communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on accessing the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SSelf   
November 17, 2005